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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/880,321	06/12/2001	Dean S. Nelson	10007613-1	5515

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EXAMINER	
KISS, ERIC B	

ART UNIT	PAPER NUMBER
2122	

DATE MAILED: 08/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/880,321	NELSON ET AL.	
	Examiner	Art Unit	
	Eric B. Kiss	2122	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *12 June 2001*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *12 June 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-20 have been examined.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1-18 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 1-8, are directed merely to an abstract idea, and are not tied to a technological art, environment, or machine that would result in a practical application producing a concrete, useful, and tangible result. Abstract ideas, **Warmerdam**, 33 F.3d at 1360, 31 USPQ2d at 1759, or the mere manipulation of abstract ideas, **Schrader**, 22 F.3d at 292-93, 30 USPQ2d at 1457-58, are not patentable. See MPEP § 2106(IV)(B)(1)(a).

Claims 9 and 10, as presently written, do not make it clear whether the prescribed instructions are executable to cause a processor to carry out a process to that would result in a practical application producing a concrete, useful, and tangible result.

Claims 11 and 12, fail to recite any tangible embodiment of the data signal, and thus, the claims recite descriptive material, *per se*. Such data signals do not define any structural and

functional interrelationship between the data signal and the other claimed aspects which permit the data signals' functionality to be realized. See, for example, Warmerdam , 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory).

Claims 13-18, although reciting a "system" in each preamble, fail to recite any specific hardware elements capable of realizing any of the data or logic functionality recited in the remaining claim limitations. Such descriptions of data per se constitute non-functional descriptive material per se, and are not statutory because no physical "thing" or statutory process is described, as there are not "acts" being performed. See, for example, Warmerdam, 33 F.3d at 1361, 31 USPQ2d at 1760. In re Sarkar, 588 F.2d 1330, 1333, 200 USPQ 132, 137 (CCPA 1978). See MPEP § 2106(IV)(B)(1)(a).

4. To expedite a complete examination of the instant application, the claims rejected under 35 U.S.C. §101 (non-statutory) above are further rejected as set forth below in anticipation of Applicant amending these claims to place them within the four statutory categories of invention.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 2 recites the limitation "the computing system" in line 2. There is insufficient antecedent basis for this limitation in the claim. In the interest of compact prosecution, the Examiner subsequently interprets "the computing system" in claim 2 as --the computing system product-- for the purpose of further examination.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over "GNU General Public License," Version 2, June 1991 (hereinafter *GPL*).

As per claim 1, *GPL* discloses that any software product based on an outside-party's software component that is distributed under the terms of the GNU General Public License must also be distributed under the terms of the GNU General Public License (see, for example, item

number 3 on p. 3). *GPL* further discloses that failure to comply with the terms of the GNU General Public License results in no grant of permission to modify or distribute that software component (see, for example, item number 5 on p. 3), and if the developer of the software product is not also the copyright holder of the software component, then failure to comply with the license terms (under the GNU General Public License) of the software component would likely result in a software product that improperly incorporates copyrighted material from the software component, which is prohibited by law (see, for example, item number 5 on p. 3).

While not expressly disclosed by GPL, the acts of identifying the attributes and resolving the attributes to determine licensing dependencies for the product are merely necessary steps in meeting the legal requirements of the GNU General Public License in a software product that uses (incorporates or modifies) any outside-party software component falling under the requirements of said license. While these acts are not required for the resulting product to function (in terms of computer-execution results) as intended, failure to perform these acts would be recognized by one of ordinary skill in the computer art as undesirable, as the resulting product may violate one or more legal requirements of the GNU General Public License, as discussed above. Therefore, it would have been obvious to one of ordinary skill in the computer art at the time the invention was made to perform such acts of identifying the attributes and resolving the attributes to determine licensing dependencies for the product in view of the disclosure of *GPL*. One would be motivated to do so, for example, to avoid potential civil and criminal penalties for copyright infringement.

As per claim 2, *GPL* further discloses storing the product attributes in the computing system product as a means of implementing the GNU General Public License in a software product (see, for example, "How to Apply These Terms to Your New Programs" on pp. 5-6). Therefore, for reasons stated above, such a claim also would have been obvious.

As per claims 3-5, in addition to the disclosure and reasoning applied above, to ensure full compliance with the terms of the GNU General Public License, it is further necessary for the step of identifying the product attributes to include identifying components of the product and licenses/license attributes (it is necessary, for example, to know if any software components used to arrive at the software product are licensed under the GNU General Public License and its associated terms; see, for example, item 3 on p. 3) and usage models (for example, determining whether a software component is incorporated, modified, or merely aggregated to determine compliance with the last paragraph of item 2, near the top of p. 3) associated with the components. Therefore, for reasons stated above, such claims also would have been obvious.

As per claim 6, *GPL* further discloses resolving the licensing dependencies with a second subset of the product attributes to identify a potential license for the product (as discussed above with respect to claims 3-5, it is necessary to consider multiple attributes in order to fully determine compliance with the terms of the GNU General Public License). Therefore, for reasons stated above, such a claim also would have been obvious.

As per claims 7 and 8, *GPL* discloses that any software product based on an outside-party's software component that is distributed under the terms of the GNU General Public License must also be distributed under the terms of the GNU General Public License (see, for example, item number 3 on p. 3). *GPL* further discloses that failure to comply with the terms of the GNU General Public License results in no grant of permission to modify or distribute that software component (see, for example, item number 5 on p. 3), and if the developer of the software product is not also the copyright holder of the software component, then failure to comply with the license terms (under the GNU General Public License) of the software component would likely result in a software product that improperly incorporates copyrighted material from the software component, which is prohibited by law (see, for example, item number 5 on p. 3).

While not expressly disclosed by GPL, the acts of identifying the attributes and resolving the attributes to determine licensing aspects for the product are merely necessary steps in meeting the legal requirements of the GNU General Public License in a software product that uses (incorporates or modifies) any outside-party software component falling under the requirements of said license. While these acts are not required for the resulting product to function (in terms of computer-execution results) as intended, failure to perform these acts would be recognized by one of ordinary skill in the computer art as undesirable, as the resulting product may violate one or more legal requirements of the GNU General Public License, as discussed above. Therefore, it would have been obvious to one of ordinary skill in the computer art at the time the invention was made to perform such acts of identifying the attributes and resolving the attributes to determine licensing aspects and considerations for the product in view of the

disclosure of *GPL*. One would be motivated to do so, for example, to avoid potential civil and criminal penalties for copyright infringement.

As per claims 9-20, in addition to the disclosure and reasoning applied above to claims 1-8, although these steps are not taught as being implemented through the use of a computer-readable medium having computer-executable instructions, a data signal embodied in a carrier medium, or a computing system comprising data and control logic, such computing systems, taken separately, or together with such computer-readable media and data signals, merely recite the use of known expedients in accomplishing the tasks set forth in claims 1-8. See In re Venner, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958) Broadly providing an automatic or mechanical means to replace a manual activity which accomplished the same result is not sufficient to distinguish over the prior art. Therefore, it would have been obvious to one of ordinary skill in the computer art at the time the invention was made to use such known expedients in determining/assuring license compliance in computer software technology, as discussed above with respect to claims 1-8. One would be motivated to do so achieve greater efficiency in performing the above-described tasks.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The document titled, "Frequently Asked Questions about the GNU GPL" is presumed to have been first published after the filing date of the instant application, based on the evidence available to the Examiner. However, the Examiner notes that this document describes the same version (Version 2, published in 1991) of the GNU General Public License (see p. 28) as cited by the Examiner and relied upon in the rejection of claims 1-20. Thus, the discussion in this reference may be properly relied upon in support of rejections based on the GNU General Public License Version 2.0.

10. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Eric B. Kiss whose telephone number is (703) 305-7737. The Examiner can normally be reached on Tue. - Fri., 7:30 am - 5:00 pm. The Examiner can also be reached on alternate Mondays.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Tuan Dam, can be reached on (703) 305-4552. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

EBK /EBK
August 11, 2004

TUAN DAM
SUPERVISORY PATENT EXAMINER